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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/940,629

08/29/2001

Toshiya Takahashi

2001-1215A

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07/14/2006

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

TOPGYAL, GELEK W

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,629

Applicant(s)

TAKAHASHI, TOSHIYA

Examiner

Gelek Topgyal

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 23 and 26 are drawn to an auxiliary information generation method including the feature of “generating auxiliary information relating to digital data when the digital data is generated; and recording or transmitting the generated auxiliary information together with the digital data”, classified in class 386, subclass 95.
 - II. Claims 9-16, 21, 22, 24 and 27 are drawn to a video data generation method, playback method and playback apparatus including the feature of “reducing the length of the digital data including video on the basis of auxiliary information relating to the digital data, thereby generating reduced digital data; and recording, transmitting or displaying the reduced digital data”, classified in class 386, subclass 109.
 - III. Claims 17-20, 25 and 28 are drawn to a video data generation including the feature for “selecting at least one piece of digital data from plural pieces of digital data including video, on the basis of information relating to the digital data and information relating to transmission; and recording or transmitting the selected digital data”, classified in class 386, subclass 46.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions as disclosed above in Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination that teaches the feature for “generating auxiliary information relating to digital data when the digital data is generated; and recording or transmitting the generated auxiliary information together with the digital data” as recited in claims 1-8, 23 and 26 of Group I, has separate utility such as the feature of “reducing the length of the digital data including video on the basis of auxiliary information relating to the digital data, thereby generating reduced digital data; and recording, transmitting or displaying the reduced digital data”, as recited in claims 9-16, 21, 22, 24 and 27 of Group II. See MPEP § 806.05(d).

3. Inventions as disclosed above in Group I and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination that teaches the feature for “generating auxiliary information relating to digital data when the digital data is generated; and recording or transmitting the generated auxiliary information together with the digital data” as recited in claims 1-8, 23 and 26 of Group I, has separate utility such as the feature of “selecting at least one piece of digital data from plural pieces of digital data including video, on the

basis of information relating to the digital data and information relating to transmission; and recording or transmitting the selected digital data”, as recited in claims 17-20, 25 and 28 of Group III. See MPEP § 806.05(d).

4. Inventions as disclosed above in Group II and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination that teaches the feature for “reducing the length of the digital data including video on the basis of auxiliary information relating to the digital data, thereby generating reduced digital data; and recording, transmitting or displaying the reduced digital data”, as recited in claims 9-16, 21, 22, 24 and 27 of Group II, has separate utility such as the feature of “selecting at least one piece of digital data from plural pieces of digital data including video, on the basis of information relating to the digital data and information relating to transmission; and recording or transmitting the selected digital data”, as recited in claims 17-20, 25 and 28 of Group III. See MPEP § 806.05(d).

5. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

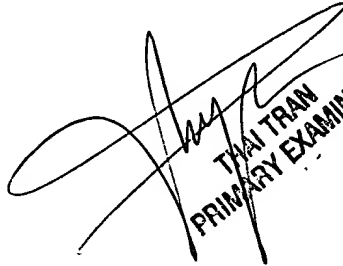
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gelek Topgyal
7/7/2006



THAI TRAN
PRIMARY EXAMINER